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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/757,426 | 01/15/2004 | Takashi Horikawa | 8005-1014 | 3365 |
| 466 | 7590 | 03/19/2007 | EXAMINER | |
| YOUNG & THOMPSON | | | CRAIG, DWIN M | |
| 745 SOUTH 23RD STREET | | | ART UNIT | PAPER NUMBER |
| 2ND FLOOR | | | 2123 | |
| ARLINGTON, VA 22202 | | | | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE | | |
| 3 MONTHS | 03/19/2007 | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|---------------------------|-------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/757,426 | HORIKAWA, TAKASHI | |
| | Examiner Dwin M. Craig | Art Unit 2123 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 December 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-7,9-12,14-18 and 20-22 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-7,9-12,14-18 and 20-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1, 3-7, 9-12, 14-18 and 20-22 have been presented for reconsideration based on Applicant's arguments and amended claim language.

Response to Arguments

2. Applicant's arguments see the responses on page 12, filed 12/26/2006, with respect to the rejections of claims 1-33 have been fully considered and are persuasive. The rejections under 35 U.S.C. 102(e)/103(a) of claims 1-33 have been withdrawn.

2.1 The Examiner thanks the Applicant for providing a substitute specification and hereby withdraws the earlier objection to the same.

2.2 The Examiner thanks the Applicant for canceling claim 22 and withdraws the objection to the same.

2.3 Regarding Applicant's arguments and amended claim language to overcome the 35 U.S.C. 101 rejections of claims 1-33, the Examiner respectfully traverses Applicant's arguments.

Applicant argued on page 11 of the 12/26/2006 responses,

The presentation of this result provides a useful result that avoids the rejection. One of skill in the art will recognize that presentation of the system performance is inherent in a system performance prediction model and this feature need not be explicitly recited in the application as filed.

The examiner notes that the only structural support for the claimed *prediction means* is a box labeled as such in figure 1 is item # 40 labeled "SYSTEM PERFORMANCE PREDICTION MEANS" in figure 6 there is an empty box without a label after item # 29 which is labeled

“PERFORMANCE ANALYSIS MEANS” in figure 13 there is again box #40 labeled “SYSTEM PERFORMANCE PREDICTION MEANS” in figure 14 there is box # 200 pointing to box #40 labeled “SYSTEM PERFORMANCE PREDICTION MEANS” and the same is true in Figure 14, the specification is silent regarding any *presentation means* and therefore no clear teaching of a method of conveyance of the system performance result is being supported by the specification. The current claim language fails to describe a method of conveying the performance prediction result into the “real world” further, the specification fails to teach or suggest a means of conveyance, therefore the newly presented claimed limitation of *presents a system performance prediction* has failed to clearly teach a concrete, useful and tangible result as required by 35 U.S.C. 101.

Specification

3. The attempt to incorporate subject matter into this application by reference to (*non-patent literature 1*) on page 15 lines 18 and 19 of the newly submitted substitute specification is ineffective because the reference document is not clearly identified as required by 37 CFR 1.57(b)(2)).

The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation

to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3-7, 9-12, 14-18 and 20-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4.1 Claims 1, 3-7, 9-12, 14-18 and 20-22 are directed towards a system performance prediction. The claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for presentation of a system performance prediction. This produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

Further, it is unclear for the current claim language or the specification what the exact conveyance is being utilized such that the performance prediction is being presented to a user or into the real world.

Amendment is required.

Allowable Subject Matter

5. Any indication of allowable subject matter is being held in abeyance pending the resolution of the 35 U.S.C. 101 rejections as presented above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

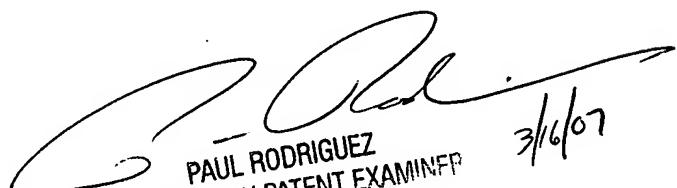
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwin M. Craig whose telephone number is (571) 272-3710. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul L. Rodriguez can be reached on (571) 272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dwin McTaggart Craig


PAUL RODRIGUEZ
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3/6/07